REMARKS

In accordance with the foregoing, claims 7 and 10-13 have been amended. New claims 21-36 are presented. Claims 1-36 are pending and under consideration.

Initially, Applicants acknowledge with appreciation the indication that claims 1-9 were allowed.

I. REJECTION OF CLAIMS 10-20 UNDER 35 USC 103 AS BEING UNPATENTABLE OVER CULLEN ET AL. (US PAT. NO. 5,732,230, "CULLEN") IN VIEW OF SETO ET AL. (US PAT. NO. 5,627,651, "SETO").

Cullen discusses scanning in images in a number of different fragments that are displayed in separate portions of the display. (see Cullen col. 3, lines 4-24 and FIG. 5). Cullen generally discusses drag and drop operations (see Cullen et al. col. 6, lines 11-23; FIG. 3, steps 112 and 114). That is, Cullen discusses that image fragments that are already on screen after a scanning operation may be moved around on the screen via drag and drop to different locations.

Seto discusses a method of smoothing bit map data representing characters or patterns to improve print quality. (see Seto col. 1, lines 9-15). Seto discusses modifying a pixel to be printed by temporarily storing the pixels in matrix memory means and then modifying the data so that the contour of the pattern formed appears smoother. (see Seto col. 9, lines 41-56).

Claims 10-13

Applicants respectfully traverse the Examiner's 103 rejection of claims 10-13, as a prima facie case of obviousness has not been properly established. To establish a prima facie case of obviousness there must be a suggestion or motivation to combine reference teachings. (MPEP §2142). The prior art must suggest the desirability of the claimed invention. (MPEP 2143.01).

The Examiner states that Cullen does not teach or suggest "vacant storage areas arranged in a matrix to have images inserted," as recited in claim 10. The Examiner cites Seto for teaching a matrix memory and storing image data in the matrix memory. (see Action page 2, and Seto col. 4, lines 6-8). The Office Action recites that the combination would have been obvious to one skilled in the art because it would be used to store the image data of Cullen in the matrix memory of Seto. (see Action at page 2).

However, assuming that Cullen and Seto are properly combinable, such a combination uses the present invention as the motivation for storing image data into a matrix of unit storage

areas. This is improper hindsight analysis. As stated in the MPEP, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." No other motivation is provided in the Action.

Additionally, the combination of Cullen and Seto would alter the "principle of operation" of Cullen. For example, one of the main principles of the operation of Cullen is that the image fragments that have been scanned in can be moved around on the screen by drag and drop operations to form a composite image that may be output once the fragments have been aligned in a desired fashion. (see Cullen et al. col. 6, lines 11-23; FIG. 3, steps 112 and 114). Applying the matrix memory of Seto to Cullen would render the manner of manipulation of Cullen inoperable as the combination does not teach or suggest how the image fragments scanned in by Cullen into a matrix memory of Seto could be manipulated to create a new composite image. Further, the matrix memory of Seto corresponds to pixel dots of black or white rather than complex images. (see Seto col. 11, lines 40-48). Seto alters individual pixel elements of the matrix memory to execute a smoothing process of changing the matrix memory areas from black to white or from white to black to make the image appear smoother when printed.

For example, claim 11, which depends from independent claim 10, recites, "**unit storage areas having different capacities**, wherein the composite image is composed of the **unit images having different dimensions**." Assuming for the sake of argument that Cullen and Seto are combinable, the pixels of Seto are of uniform size and thus, the combination of Cullen and Seto would not teach or suggest at least the highlighted portion of claim 11 because of the uniformity of the memory of Seto. Thus, the references either alone or in combination are not sufficient to render the claims prima facie obvious.

Furthermore, Cullen does not discuss what we believe to be one of the patentably distinguishing features of the present invention, namely that the images are insertable into "an aggregation of unit areas arranged in a matrix," as recited in claim 13. (see 09/737,489 page 10, lines 6-12 as an example). Pixels are not equivalent of insertable images. Furthermore, nothing in Seto discusses that the pixels are "insertable."

In view of the above, it is respectfully submitted that the rejection of claims 10-13 is overcome.

Claims 14-20

Regarding claims 14-20, in addition to being allowable based on their dependency, either directly or indirectly, from allowable claim 1, claims 14-20 of the subject application recite

patentably distinguishing features of their own. For example, claim 14 recites, "wherein dimensions of the blocks are specified irrespective of dimensions of the processing target image, and the processing target image is adjusted to the dimensions of the block that accepts the inserted image." Cullen, as admitted in the Action at page 2, does not teach vacant blocks arranged in a matrix. Therefore, Cullen also does not that the dimensions of such blocks are adjustable irrespective of the dimensions of the processing target image. Furthermore, claims 14-20 are allowable for at least their dependence from allowed claims as a matter of law. In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

II. NEW CLAIMS 21-36.

New claims 21-36 are similar to claims 1-9 and 14-20, though the new claims do not recite a display unit. Thus, the claims are believed allowable for similar reasons to claim 1. For example, the cited references do not teach or suggest "a controlling unit for dividing a portion of a display into a predetermined composite area, wherein the composite area includes a plurality of vacant blocks arranged in a matrix and each of the plurality of blocks may have a processing target image inserted from a source or any of the plurality of blocks may be left vacant," as recited in claim 21.

III. CONCLUSION.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Applicants believe that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: May 14, 2004

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